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TMIN THE UNITED STATES PATENT AND TRADEMARK OFFICEBEFORE THE BOARD OF APPEALS

Applicant:

Anthony Maglica

Serial No. 07/411,576

Filed: September 22, 1989

For: FLASHLIGHT

) Group Art Unit 291

) Examiner S. Lucas

93-0363

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Lynette Telles

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9-17-92

Date of Signature

Honorable Commissioner of  
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Sir:

INTRODUCTION

This is in reply to the Examiner's Answer dated August 13, 1992. The main issue presented for review is the factual issue of whether the contour or profile of the head of the flashlight shown in the present formal drawings is, for purposes of priority, supported by the profile of the head of the flashlight shown in Figures 2 and 3 of the original patent drawings, referred to as the "648,032 drawings". Applicant submits that the profile of the head of the flashlight in Figures 2 and 3 of the 648,032 drawings includes a curved portion. The Examiner's position is as follows:

"Specifically, Figs. 1-3 of the parent application show a flashlight head with a distinct change in plane. A planer surface meets another planar surface at a

distinct intersection, on the surface of the flashlight head." (Examiner's Answer, p. 6).

Applicant submits that the Examiner's position is not well founded for the following reasons:

(1) There is a figure inconsistency between Figure 1 and Figures 2 and 3 of the 648,032 drawings and reliance by Applicant on Figures 2 and 3 is sufficient to support the present formal drawings;

(2) The Examiner previously admitted that the profile of the head of the flashlight shown in the 648,032 drawings involves a curved surface;

(3) The Examiner's only attempt to objectively support her present position, that the profile of the head of the flashlight shown in Figures 2 and 3 of the 648,032 drawings is angular, is skewed and misleading;

(4) The Examiner has not given adequate consideration to the declaration of Fred McAlister because she misconstrued the procedure by which the profile of the head of the flashlight shown in Figure 2 of the 648,032 drawings was duplicated for the purpose of drawing the profile of the head of the flashlight in the present formal drawings; and

(5) The objective evidence submitted by the Applicant outweighs the Examiner's subjective position that "[A] direct visual comparison of the claimed design of the instant application with the figure views of the parent application show that the head shapes are different". (Examiner's Answer, p. 7).

The Examiner also rejected the claimed invention under 35 U.S.C. § 112, First Paragraph. The Examiner contends that the light at the candle end of the flashlight shown in the present formal drawings is different than what is shown in the 648,032 drawings and that the present formal drawings show "a significant proportional difference in the candle end - a wider and taller threaded end and a smaller flat top disc". (Examiner's Answer, p. 4). As set forth below, it is believed that this rejection is primarily a communication problem.

#### ARGUMENT

##### 1. The Rejection Under 35 U.S.C. § 103

Because of the Examiner's position that the shape of the flashlight head shown in the present formal drawings is different from the shape of the flashlight head shown in the 648,032 drawings, the Examiner has denied the present application the benefit of priority of the prior utility application, Serial No. 648,032, filed on September 6, 1984. Such priority would overcome the Examiner's rejection of the present application under 35 U.S.C. § 103.

##### a. The Examiner's Visual Observations of The 648,032 Drawings Have Been Inconsistent

It is Applicant's position that the curved shape of the flashlight head in the present formal drawings is supported by Figures 2 and 3 of the 648,032 drawings. Indeed, Applicant submitted declarations by an engineer, Fred McAlister, explaining that the curved profile of the flashlight head in the present formal drawings was duplicated from the profile of the flashlight

head shown in Figure 2 of the 648,032 drawings. Applicant has also submitted several overlays in order to permit an objective comparison of the profile of the flashlight head in the present formal drawings with the profile of the flashlight head shown in Figure 2 of the 648,032 drawings.

Applicant concedes that the flashlight head shown in Figure 1 of the 648,032 drawings is not curved, but is instead angled or, to use the words of the Examiner, "[A] planar surface meets another planar surface at a distinct intersection on the surface of the flashlight head." (Examiner's Answer, p. 6). However, this figure inconsistency between Figure 1 and Figures 2 and 3 of the 648,032 drawings is not a basis for holding that the present design application is not supported by the 648,032 drawings of the original utility drawings. As held in Ex Parte Asano, 201 U.S.P.Q. 315, 318 (Bd. App. 1978) support "anywhere in the drawings" is sufficient.

The Examiner in her Answer insists that the rejection is not based merely on Figure 1 of the 648,032 drawings. (Examiner's Answer, p.6). It is her present position that Figures 1-3 of the 648,032 drawings are consistent (Examiner's Answer, p. 7) and that each of Figures 1-3 of the 648,032 drawings show a flashlight head with a distinct change in plane where a planar surface meets another planar surface at a distinct intersection on the surface of the flashlight head." (Examiner's Answer, p. 6). The Examiner has also dismissed the declarations and technical data submitted by Applicant, stating "[W]ritten declarations and technical data cannot prove nor disprove what visually occurs on paper." (Examiner's Answer, p. 9).

However, what the Examiner now says is so clearly shown by her visual observation of the 648,032 drawings is not consistent with what she said after a previous observation of these same 648,032 drawings. In an April 12, 1991 Office Action in a companion case, Serial No. 410,95, the Examiner stated as follows:

"The contour line of the head in the 648,032 goes from a straight surface to a curved surface . . . ".

This is inconsistent with her present position that Figures 2 and 3 of the 648,032 drawings, show a head profile where "[A] planar surface meets another planar surface at a distinct intersection on the surface of the flashlight head." (Examiner's Answer, p. 6). Obviously, when a straight surface goes to a curved surface there is no distinct intersection. Only Figure 1 of the 648,032 drawings shows two planar surfaces meeting at a distinct intersection. Indeed, the present formal drawings, like Figures 2 and 3 of the 648,032 drawings, show a flashlight head having a contour line which " . . . goes from a straight surface to a curved surface." To the extent the Examiner contends her prior observation regarding what is shown in the 648,032 drawings concerning the contour of the flashlight head is a mistake, it merely proves that her subjective visual observation of the drawings is less reliable than the declarations and technical data submitted by the Applicant.

**b. The Examiner's Objective Evidence Is Flawed**

In the Appeal Brief in the companion case, Serial No. 410,965, we relied on a series of transparencies and photocopies attached to that Appeal Brief as Exhibits I and II and on the comparisons set forth in the Declarations of Fred McAlister dated

December 23, 1991 and November 21, 1991. This evidence demonstrates that the profile of the head of the flashlight in the present formal drawings is the same as the profile of the head of the flashlight shown in Figures 2 and 3 of the 648,032 drawings.<sup>1/</sup> (See Exhibit I and Exhibit II, the originals of which are attached to the Appeal Brief in the companion case, Serial No. 410,965).

The Examiner, in an attempt to rebut this evidence and objectively support her present position, that the contour or profile of the flashlight head shown in the 648,032 drawings involves two planar surfaces meeting at a distinct intersection, drew straight lines (C) on Figures 1 and 2 of the 648,032 drawings and straight lines (D) on Figures 1 and 2 of the present formal drawings. This intersecting line presentation is an invalid comparison because the lines can be skewed to provide a misleading result. For example, on the drawings submitted by the Examiner, the line (C) extending from the rear portion of the flashlight head in Figure 2 of the 648,032 drawings is clearly drawn inside the outside edge of the contour line whereas the line (D) extending from the rear portion of the flashlight head in Figures 1 and 2 of the present formal drawings is drawn outside the outside edge of the contour line. This inconsistency clearly distorts the results and invalidates the comparison.

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<sup>1/</sup>This evidence clearly rebuts the Examiner's position that " . . . the head in the newest set of submitted drawings (1/7/92) is not similar to the head shape of the parent applications." (Emphasis added.) (Examiner's Answer, p. 8). Even if there are slight differences, it cannot be said that the head shape shown in the present formal drawings is not similar to the head shape shown in Figures 2 and 3 of the 648,032 drawings.

This same type intersecting lines presentation was set forth in Photoprints A and B which were attached to the Examiner's Answer in the companion case, Serial No. 410,965. In the Exhibits attached to Mr. McAlister's declarations dated November 21, 1991, Mr. McAlister demonstrated, by using enlargements of Photoprints A and B, the problems with the Examiner's intersecting lines presentation.

The enlarged Photoprints A and B show how the Examiner skewed the lines in her intersecting lines presentation to effect the result. As seen in the enlargements of Figures 2 and 3 of Photoprint A (Exhibits VII and VIII of the McAlister declaration), the Examiner, in trying to show that the contour of the head of the flashlight in Figures 2 and 3 of the original drawings conformed to the shape of straight intersecting lines, drew the lines inside the outside edge of the contour line. This is apparent because a portion of the fuzzy or rippled contour line created by poor resolution can be seen on the outside of the straight lines. See in particular the straight line as indicated by the letter "Y" extending from the barrel end of the head in Figure 2, Exhibit VII and the highlighted portion of the rippled contour line outside of the straight line. (McAlister Decl., pp. 5-6, para. 18).

This method used by the Examiner of drawing the intersecting lines inside the outside edge of the contour line is an incorrect method because if you wanted to determine whether the surface of an actual part was curved or straight you would place a straight-edge on the surface of the part which would be the equivalent of the outside edge of the contour line not inside the outside edge

of the contour line. This incorrect method obscures the space between the intersecting straight lines and the contour line. Applying a correct method of drawing the intersecting lines on the outside edge of the contour line with a precise and relatively thin line, as Mr. McAlister did on the opposite contour lines of Figures 2 and 3 in Exhibits VII and VIII, shows that the contour is curved and does not conform to the intersecting lines. (McAlister Decl., pp. 5-6, para. 18).

Referring now to Exhibits IX and X of the McAlister declaration, which are enlargements of Figures 1 and 3 of Photoprint B, the present formal drawings in the companion case, Serial No. 410,965, <sup>2/</sup> the Examiner, in direct contrast to what she did in Photoprint A, drew the intersecting straight lines on the outside edge of the contour line or beyond the outside edge in an obvious attempt to try to demonstrate a difference between the flashlight head contours in Figures 2 and 3 of Photoprint A and the flashlight head contours in Figures 1 and 3 of Photoprint B. The Examiner has done the same thing in this case in the intersecting lines presentation involving lines (C) and (D).

To further demonstrate the misleading nature of the Examiner's intersecting lines presentation, Mr. McAlister applied the Examiner's incorrect method used in Photoprint A to the enlargements of Photoprint B. By drawing the intersecting lines on the contour line or on the inside edge of the contour line, as

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<sup>2/</sup>The profile of the flashlight head shown in the present formal drawings in this case is identical to the profile of the flashlight head shown in the formal drawings for Serial No. 410,965.



Mr. McAlister did in red on the opposite contour line of the enlarged Figures 1 and 3 of Photoprint B, the space between the curved contour line and the intersecting straight lines is obscured and makes it appear even on the enlarged copy that the curved contour line conforms to the intersecting straight lines. (McAlister Decl., p. 6, para. 19).

Referring to Exhibits XI and XII of Mr. McAlister's declaration, these were taken from a better resolution copy of the first sheet of the original patent drawings. Note how much heavier the item numbers are in Exhibits VII and VIII, which were made from the copy used by the Examiner as Photocopy A. Again, by applying intersecting lines in the correct method, it is seen that there is a space between the contour of the head of the flashlight in Figures 2 and 3 of the 648,032 drawings and the intersecting straight lines and that the contour is curved and does not conform to the straight intersecting lines. (McAlister Decl., p. 7 para. 20).

Exhibits XIII and XIV of Mr. McAlister's declaration were made because these were taken from the printed patent drawings of U.S. Patent No. 4,577,263 and have the best resolution. Again, by applying intersecting lines in the correct method, it is seen that there is a space between the contour of the head of the flashlight in Figures 2 and 3 and the intersecting straight lines and that the contour is curved and does not conform to the straight intersecting lines. (McAlister Decl., p. 7, para. 21).

Exhibit XV of the McAlister declaration is an overlay which further demonstrates that even on a greatly enlarged scale the

curved contour or profile of the head of the flashlight in the present formal drawings, as shown in the upper transparency, closely conforms to the contour or profile of the head of the flashlight in Figure 2 of the original patent drawings, as shown in the bottom opaque velox. (McAlister Decl., pp. 5, 7, paras. 17, 22).<sup>3/</sup>

To the extent that any small differences exist between the profile of the flashlight head of the present formal drawings and the profile of the flashlight head of Figures 2 and 3 of the 648,032 drawings, they could not be perceived by the human eye if the drawings were normal size. Furthermore, such minor differences are inconsequential. Even the Examiner concedes that the issue is whether the design of the present application is "similar" to that of the parent utility application. (Examiner's Answer, p. 8).

c. The Examiner Has Misconstrued The Method of Duplication  
By Mr. McAlister

Mr. McAlister in his declarations dated February 8, 1991 and May 28, 1991 set forth the steps which he used to duplicate the profile of the head of the flashlight shown in Figure 2 of the 648,032 drawings for purpose of drawing the flashlight head shown

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<sup>3/</sup>In addition to showing that the Examiner's intersecting lines presentation is flawed, Exhibits VII-XV also demonstrate that, when the intersecting lines presentation is properly applied, Figures 2 and 3 of the 648,032 drawings include a curved surfaced and not a distinct intersection. Copies of the exhibits attached to Mr. McAlister's November 21, 1991 declaration, including Exhibits VII - XV, are attached hereto for the Board's convenience. However, Applicant requests that the Board review the originals, which are with the companion case, Serial No. 410,965.

in the present formal drawings. The Examiner has disregarded this evidence for the following reason:

" The description of the technical data discussed by Fred McAlister is also not convincing. The examiner does not doubt that a process of hand plotting points into computer aided drafting equipment was used in creating the new sets of drawings. However, the examiner wishes the emphasize that the points were hand plotted from an enlargement of a copy of the originally submitted drawing. It is feasible to assume that an enlargement of a drawing may widen and distort the contour line and give adequate room for unintentional adjustments in the plotted points, which may significantly affect the final product. In light of this explanation, and the belief that the appearances are visually different, the examiner maintains that the head in the newest set of submitted drawings (1/7/92) is not similar to the head shape of the parent applications." (Emphasis added) (Examiner's Answer, p. 8).

The Examiner is wrong. The points which Mr. McAlister hand plotted were not hand plotted from an enlargement of a copy of the original submitted drawing. To the contrary, as set forth in Mr. McAlister's declarations of February 8, 1991 and May 28, 1991, a copy of Figure 2 of the 648,032 drawings was used in connection with transparent engineering graph paper on which the points were plotted and, to insure accuracy, Mr. McAlister observed Figure 2 and the engineering graph paper under a ten-

power fluorescently illuminated magnifier.<sup>4/</sup> Since the Examiner clearly misconstrued the procedure by which Mr. McAlister duplicated the profile of the flashlight head of Figure 2 of the 648,032 drawings, it is equally clear that she was in error in dismissing the significance of this evidence.

2. The Rejection Under 35 U.S.C. § 112, First Paragraph

The Examiner's rejection of the claimed invention under 35 U.S.C. § 112, First Paragraph, involves the following perceived problems:

- "a) In the new drawing, the candle end of the flashlight is different than the candle end of the original drawing. The new drawing (1/7/92) shows a partially uncovered light. The original drawing shows a completely covered light. Note A Fig. 1 on the new drawing and Figs. 1 (formal) and 8 (informal) on the original drawings.
- b) The new drawing shows a significant proportional difference in the candle end - a wider and taller threaded end and a smaller flat top disc. Note B Figs. 1, 2, 3 on the new drawing and Fig. 8 on the original drawings."

(Examiner's Answer, pp. 4-5)

These perceived problems were first raised by the Examiner in an Office Action mailed July 18, 1991 in response to a first

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<sup>4/</sup>Furthermore, if there had been adjustments in the plotted points to significantly affect the final product, as suggested by the Examiner (Examiner's Answer, p. 8), any discrepancy between the profile of the flashlight head shown in Figure 2 of the 648,032 drawings and the profile of the flashlight head shown in the present formal drawings would be seen when comparing the overlays.

set of amended drawings submitted on May 29, 1991 to overcome certain other objections by the Examiner. Despite the fact that Applicant considered these amended drawings to be reasonably supported by the original 648,032 drawings pursuant to MPEP § 1505, Applicant submitted a second set of amended drawings on January 7, 1992 which modified the first set of amended drawings. These are the present formal drawing and they were submitted specifically as an attempt to overcome the exact problems now raised by the Examiner. That is, in response to the Examiner's rejections, the light was changed, the width and height of the threaded end was decreased and the diameter of the flat top disc was increased. These changes were never acknowledged by the Examiner. Instead, in an Office Action mailed on February 6, 1992, the Examiner merely stated:

"The proposed drawings do not overcome the rejection under 35 U.S.C. § 112 par. 1 for new matter - characteristics c and d set forth in paper #12 have not been corrected."

a. The Basis For The Examiner's Rejection  
Is Unclear

The problem with this rejection under 35 U.S.C. § 112, First Paragraph, is that it is not clear what it is that the Examiner finds objectionable about the present formal drawings. The Examiner has merely designated areas where the perceived problems exist. For example, it is not clear what is meant by the Examiner when she states that the " . . . new drawing shows a partially uncovered light" and the " . . . original drawing shows a completely covered light." The light is not "covered" in any of the drawings. What is meant by "uncovered" and "covered"? We

are equally uncertain with regard to the dimensional differences perceived by the Examiner with respect to the threaded end and the disc. Apparently the changes we made were perceived by the Examiner as inadequate, but how much narrower and shorter does the threaded end need to be and how much larger does the disc need to be are questions which can't be answered without some further clarification of the perceived problems by the Examiner.

Applicant is not unwilling to modify the drawings to overcome these problems and has already attempted to do this. However, because these perceived problems are clearly within the eye of the beholder, specific directions need to be given by the Examiner as to how the drawings should be changed.

**b. The Present Drawings Are Reasonably Supported  
By The Original Drawings**

Even though Applicant is willing to further amend the present formal drawings to overcome the 35 U.S.C. § 122, First Paragraph, rejection, it is not believed that this rejection is well taken. First, there is no indication that the Examiner has even considered Figure 5 or Figures 2 and 3 of the 648,032 drawings in connection with this rejection. It is submitted that these figures when viewed together clearly support the illustration of the light, the threaded end and the disc in the present formal drawings. Reasonable support is all that is required. MPEP § 1505. Furthermore, as made clear by the Board in Ex Parte Asano, 201 U.S.P.Q. 315 (Bd. App. 1978) at 317:

" . . . neither the statute (35 U.S.C. § 112) nor the regulation (37 CFR 1.152) requires blueprint type drawings of an exact scale."

The Examiner also contends that the differences with respect to the light on the candle end and the proportion of the threaded end are significant because "[A] change which may appear slight, relative to other articles of manufacture, may actually be a major distinguishing change, as is the case there, in view of the flashlight art." (Emphasis added) (Examiner's Answer, p. 12). However, this contention by the Examiner is inconsistent with her earlier assertion that "[T]he Maglica patent, Fig. 8, shows a flashlight of essentially the same appearance as the claimed design except for the rounded head. (Emphasis added.) (Examiner's Answer, p. 3). If these perceived differences with respect to the light and the threaded end involve distinguishing differences, how can the Examiner on the other hand assert that Figure 8 of the Maglica patent, which is identical to Figure 8 of the 648,032 drawings, shows a flashlight which is essentially the same in appearance as shown in the present formal drawings?

To the extent any difference exists with respect to the light, the threaded end and the disc between the 648,032 drawings and the present formal drawings, Applicant submits that it is clearly insignificant. It is only necessary that one of ordinary skill in the art be able to make the disclosed design. Ex Parte Asano, supra.

#### CONCLUSION

The Examiner's position that the shape of the flashlight head shown in the present formal drawings is different and not supported by the flashlight head shown in Figures 2 and 3 of the 648,032 drawings is based on the Examiner's visual observation,

which has been inconsistent on what the drawings show, and a fatally flawed intersecting line comparison. The Examiner has also misconstrued the evidence which shows that the flashlight head shown in Figures 2 and 3 of the 648,032 drawings includes a curved surface and thus she has failed to give adequate consideration to such evidence. The Examiner's rejection of the claimed invention under 35 U.S.C. § 112 is uncertain and any differences perceived by the Examiner between what is shown in the 648,032 drawings and the present formal drawings are inconsequential. Thus, Appellant again respectfully requests that the rejection be reversed and that the present application be allowed to issue.

Respectfully submitted,

LYON & LYON

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